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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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LATHROP & GAGE LC 2345 GRAND AVENUE SUITE 2800 KANSAS CITY, MO 64108			EXAMINER CHAPMAN, JEANETTE E	
			ART UNIT 3633	PAPER NUMBER
			MAIL DATE 02/25/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/797,203

Applicant(s)

STEWART, PHIL

Examiner

Jeanette E. Chapman

Art Unit

3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11, 16, 19-22, 24-25, 33-39 rejected under 35 U.S.C. 102(b) as being anticipated by Clary.

Clary discloses a form or molded article 14 configured for fitting over a surface of an existing tile 10. The article or decorative cap 14 includes:

- A first surface 22
- A second surface 54, oppositely disposed from each other
- The first and the second surface and including at least one edge defined by the convergence of the second surface toward the first
- The at least one edge configured for conforming with a corresponding edge of the tile 10
- A mastic adhesive in communication with the second surface; see column 3 lines 12-18; thus meeting the limitations of claim 11;
- The molded article is selected from the group consisting of a plastic article; column 3, lines 20-25;
- The material of the tile has been considered immaterial since applicant is not positively claiming the tile and especially not claiming the combination of the tile and the tile cap; further Clary leaves the possibility of the types of materials open

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to the particular tile of use. One of ordinary skill in the art would have selected any material known in the art and suitably combined with the tile cap of Clary. Such a selection is well within the scope of Clary.

- Though claim 19 is a product by process limitation, the tile cap is applied a a surface without grout
- The tile cap has a trimmable knife edge 36; since the material is a compressible plastic the same is obviously trimmable.
- The method steps are met by Cary as the same provides the above structure
- Cary also shows the tile cap positioned over the existing tile

Claims 1-11, 16, 19-22, 24-25, 33-39 rejected under 35 U.S.C. 102(b) as being anticipated by Clary

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-15, 23, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clary in view of Zinbarg (5946869).

Further, the type of adhesive is obviously not critical to the invention in view of the fact that applicant has claimed every type of adhesive known in the art. Given the lack of criticality and relevancy, one of ordinary skill will have been able to select any adhesive that would function as intended. Nevertheless, Zinbarg discloses a plastic

material over a panel employing double sided foam tape. Zinbarg also suggest the use of other known adhesives. See column 4, lines 1-35. It would have been obvious to employ any adhesive suitable for use such as the double sided foam tape which prevents marring of the panel surface.

Claims 17, 18, 27, 30 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clary in view of Stoneburner (3359574). Clary lacks the molded article with germicidal and bacteriostatic characteristics. Given the use of the tile cap of Cary one would desire a cap with germicidal and bacteriostatic characteristics given the pool water is protected against germs and bacteria by the use of chlorine. Stoneburner discloses a wall panel of fiberglass plastic including "impregating the same with a suitable germicidal agent..... in order to kill bacteria.... " One of ordinary skill in the art would have appreciated adding these materials as a further means of protections to users.

Claims 28-29, 31, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clary in view of Stoneburner (3359574) and Zinbarg (5946869)

The base reference has been considered as described above and the secondary references are considered and applied as described above.

Response to Arguments

Applicant's arguments are not persuasive.

Applicant has amended the claims to recite a tile cap for "...configured for fitting over an existing tile surface". However, the claims do not recite the tile cap fitting over

the entire surface. The tile cap such as that disclosed by the base reference may fit over a portion of the surface and still be considered and interpreted as fitting over the surface.

Conclusion

This is a RCE of applicant's earlier Application. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chapman E. Jeanette whose telephone number is 571-

272-6841. The examiner can normally be reached on Mon.-thursday, 8:30-6:00, every fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-66843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JEANETTE CHAPMAN/
PRIMARY PATENT EXAMINER
ART UNIT 3633